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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/063,398   | 04/18/2002  | John Bradford Reitz  | RD29180-2           | 7869             |
| 23413  | 7590        | 05/25/2005           | EXAMINER            |                  |
| CANTOR COLBURN, LLP<br>55 GRIFFIN ROAD SOUTH<br>BLOOMFIELD, CT 06002 |             |                      | TUROCY, DAVID P     |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1762                |                  |

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/063,398

Applicant(s)

REITZ ET AL.

Examiner

David Turocy

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 May 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.

b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: \_\_\_\_\_.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Detailed Action.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.



## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 5/12/2005 have been fully considered but they are not persuasive.

The applicant argues the prior art does not teach of a solution solvent with the specific properties as claimed. Also the applicant has argued that the solution mixture, 5-60 % propylene glycol and another solution solvent, of the prior art does not meet the properties of the claim. While the examiner agrees Mishina et al does not disclose particular properties of the solvent mixture, such a solvent mixture as disclosed by Mishina et al, 5% by weight of the propylene glycol derivative and 95% by weight a solvent as claimed, necessarily meets the limitations. It is the examiners position that 5% by weight propylene glycol derivative, disclosed as various acetates, ethers, and other similar compounds to those disclosed in claim 8, will not particularly alter the properties of the dominant solvent, which may be selected from N-methyl pyrrolidone , N,N-dimethylacetamide, N,N-dimethylformamide, dimethylsulfoxide, or butyrol actone (col. 4, lines 6-13) -- each of which has a boiling point in the claimed range, a polarity index of greater than or equal to about 4.0, and a pH in the range of 5.5-9, as evidenced by Applicant's own specification and dependent claim 9. The examiner also notes the comparative examples, which requires only polyimide and N-methyl pyrrolidone without the addition of the propylene glycol, which reads on the solution as claimed.

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In addition while the examiner agrees the solution as taught by Mishina does in fact contain a small portion of propylene thermoplastic polymer. Mishina teaches of a solution of a solution solvent and a thermoplastic polymer as required by the claim as written. Therefore the coating solution as taught by Mishina, comprising a solution of a solution solvent and 5-50 wt% polyimide polymer resin as discussed in Section 8 of the Office Action dated 11/17/2004, anticipates each and every element of the claim glycol, the claim does not limit the coating solution to a single solvent and a as written.

The applicant argues against the Mishina reference stating that they fail to teach of limiting the amount of the halogens and water content in the solution. The examiner respectfully disagrees. The phrase "less then or equal to" reads on a range with a lower limit of 0 and Mishina et al fails to teach of supplying halogens, particles or water within the solution, or in other words, teaches of providing no halogens, water, and particles, therefore Mishina et al reads on the claim as written.

The applicant has argued against the Mishina reference stating that they teach that changing the solvent have significant effects on the resulting coating and cites comparative examples. The examiner respectfully disagrees that the comparative examples are a showing that changes in the properties of the solvent have significant effects on the coating. It appears to the examiner that the only difference between the examples and the comparative examples is that the comparative examples fail to include a small percentage of the propylene glycol derivative in the solvent. The

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specification discloses without this small percentage of propylene glycol the effect for smoothing the coating film tends to be inadequate (Column 3, lines 65-66), which is the basis for the comparative examples. The examiner maintains the position that the average a molecular weight,  $T_g$ , viscosity, etc. of polymer coatings are known result effective variables and therefore optimization of these characteristics would have been obvious to one of ordinary skill in the art depending upon the end use and the desired qualities of the resulting coating in the absence of showing criticality.

The applicant has argued against the Feist et al. reference stating that the reference is not a proper 103(c) reference. The argument is not persuasive because the showing that Feist et al. fails to qualify under 102(e) is improper. The applicant failed to state that the claimed subject matter of the Feist et al reference and the claimed invention were, *at the time the invention was made*, owned by the same person or subject. Therefore the rejection to Feist et al is maintained.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy  
AU 1762



**TIMOTHY MEEKS**  
**SUPERVISORY PATENT EXAMINER**